

REMARKS/ ARGUMENTS

The Office Action of February 23, 2006 has been carefully reviewed and this response addresses the Examiner's concerns. Applicant expresses his gratitude to Examiner Bello for explanatory remarks to Attorneys Jacob Erlich and Orlando Lopez.

I. Status of the Claims

Claims 1-21 are pending in this application.

Claims 19-21 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Claims 1-3, 5, 7, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Doerr (U.S. Patent No. 6,754,410) ("Doerr").

Claims 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Stone (U.S. Patent No. 5,771,320) ("Stone").

Claims 4, 6, 9, 11-14 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerr in view of Stone.

Claims 19 is amended.

II. The 35 U.S.C. 112, first paragraph rejections

Claims 19-21 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

Support for the previous amendment to claim 19, that said plurality of output beams are substantially coplanar to said plurality of input beams, can be found in paragraph 58 of the specification and Fig. 8. Claim 19 was amended to include "said plurality of redirected output beams being substantially parallel and substantially coplanar to said plurality of input beams." Paragraph 58 of the specification states that "Referring to Fig. 8, transmission switch array 700 includes the planar switch array 500 of Fig. 6a and grating 710." As shown in Fig. 8, shown below

the input beams 700 and the output beams 760 are located in the same plane and therefore substantially coplanar.

Therefore, the Applicant respectfully requests that the 35 U.S.C. 122, first paragraph rejection be withdrawn.

III. The 35 U.S.C. §102 rejections

Claims 1-3, 5, 7-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Doerr (U.S. Patent No. 6,754,410) ("Doerr").

As shown in the previously submitted Rule 1.131 declarations by the Applicant/inventor, Thomas W. Stone, and the Patent agent/attorney, Orlando Lopez, the invention was conceived before the filing date of U.S. Patent No. 6,754,410, May 29, 2003, and the inventor and his attorney diligently worked towards filing the patent application. No dates are provided for conception. Applicant's statement of the date at which Applicant left Agilent does not preclude conception while Applicant was an Agilent employee. Applicant states that the Applicant's declaration is not in error.

In the declaration enclosed, Patent agent/attorney, Orlando Lopez provides the dates relied upon for diligence. In regards to the Applicant's present patent application, the following factors should be considered in establishing due diligence. The Applicant was not employed by the assignee during the period over which diligence is established and, furthermore, the Applicant was also engaged in the review in the drafting of 8 or more other related patent applications while reestablishing his own business. The present situation is similar to that in *Bey* since the applicant and his patent attorney worked reasonably hard to prosecute a large number of related cases. Therefore, Applicant respectfully states that the diligence from prior to the filing date of the Doerr reference has been established.

The Examiner has stated that the evidence submitted in the previously submitted declarations is insufficient to establish diligence from a date prior to the date of reduction to practice of the

Doerr reference to either a constructive reduction to practice or an actual reduction to practice. The newly submitted Rule 1.131 declaration by the patent agent/attorney, Orlando Lopez, provides specific dates to establish diligence from before May 29, 2003 until the Applicant's filing of the US Patent Application. During that period, the same patent agent/attorney, Orlando Lopez, was drafting over 8 related applications having the Applicant as an inventor. Drafts of the patent application were exchanged on or about the following dates: January 28, 2003; July 1, 2003; September 9, 2003; October 7, 2003; and October 30, 2003. Applicant respectfully states that this evidence is sufficient to establish diligence.

Applicant asserts that U.S. Patent No. 6,754,410 is not a valid 35 U.S.C. 102(e) prior art reference. Since U.S. Patent No. 6,754,410 is not 35 U.S.C. 102(e) prior art, U.S. Patent No. 6,754,410 cannot anticipate the Applicants invention. The preceding assertion does not constitute acquiescence to the purported anticipation by the "Doerr" patent. Applicant respectfully requests that the Examiner find claims 1-3, 5, 7, 8 and 10 patentable.

Furthermore, regarding Claim 7, the Examiner equates the array waveguide grating (AWG) 501 to a separating diffraction grating, which is a limitation of the claim. One skilled in the art would not consider an AWG to be a separating diffraction grating. Similar remarks apply to the recombining diffraction grating, which is also a limitation of the claim. Applicant respectfully asserts that claim seven is not anticipated by the '410 patent. Claims 8-10 depend on claim 7 and therefore contained limitations that are not present in the '410 patent. Although applicant asserts that the '410 patent is not valid prior art, even if it were it would not anticipate claims 7-10.

Claims 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Stone (U.S. Patent No. 5,771,320) ("Stone" or the '320 patent).

Claims 19-21 claim a planar switch including "said second diffractive grating means receiving a plurality of output beams from said plurality of output locations and redirecting said output beams, said plurality of redirected output beams being substantially parallel and substantially coplanar to said plurality of input beams." Referring to Figs. 1-4 of the '320 patent, the '320

patent does not teach or disclose such a planar switch. Claims 20 and 21 have further patentable limitations not found in the '320 patent. The Examiner has not indicated where any specific elements of the claims are disclosed in the reference and merely relies on the '320 patent having the same inventor as the instant patent.

Referring to Fig. 1 of the '320 patent, shown below,

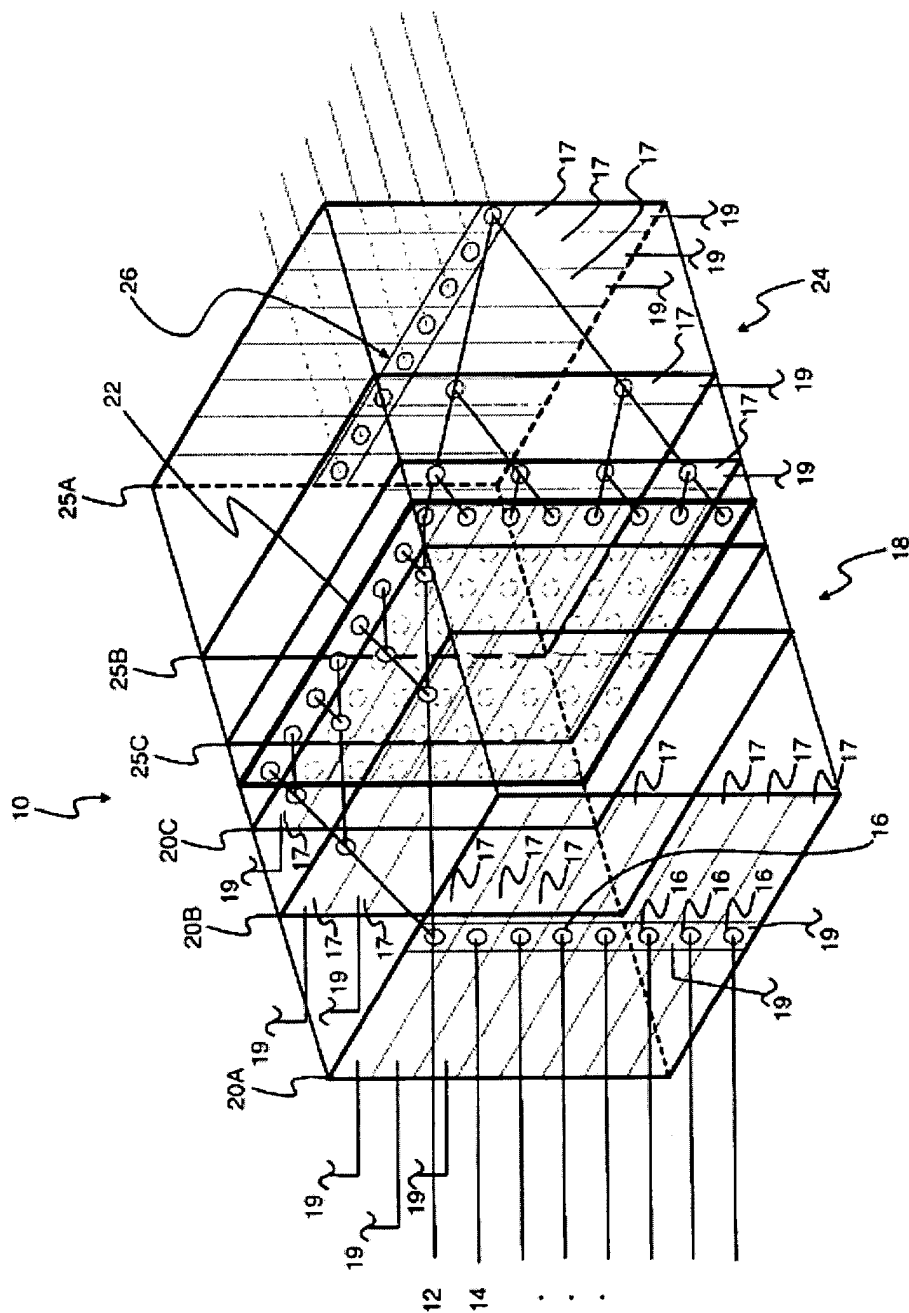


Fig. 1

the '320 patent teaches the input beams 19 being in a plane perpendicular to the plane of the output beams 26 and not substantially coplanar. Furthermore, the switch of Fig. 1 of the '320 patent is not a planar switch.

The limitations of claim 21, "a location of said second diffractive grating means being substantially coincident with extensions of substantially evenly spaced apart switchable transmissive diffractive gratings; and wherein said reflector array further redirects said plurality of output beams ensuring that said plurality of output beams remain separated," are not taught by the '320 patent.

Therefore, Applicant asserts that the '320 patent does not anticipate claims 19-21. Applicant respectfully requests that the Examiner find claims 19-21 patentable.

IV. The 35 U.S.C. §103 rejections

Claims 4, 6, 9, 11-14 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerr in view of Stone.

As stated above, Patent No. 6,754,410 is not 35 U.S.C. 102(e) prior art. This assertion does not constitute acquiescence to the purported obviousness of the claimed invention in view of the "Doerr" patent and further in view of the '320 patent. There are a number of claims, including 13, 14, 16 and 17, that have limitations not found in either one of the references.

Regarding claim 14, Claim 14 claims an optical system wherein the "selectable switching and routing sub-system comprises a planar switchable mirror based sub-system." As stated above, the '320 patent (Stone) and does not teach a planar switchable subsystem and, therefore, does not teach a planar switchable mirror based subsystem (referred to figure 1 of the '320 patent). Therefore claim 14 has at least one limitation which is not present in or implied by the '410 patent or the '320 patent or their combination.

Regarding claim 17, although anamorphic optics, like almost all optical elements, are known in the art, there is no teaching in the '410 patent regarding the use of anamorphic optics or a motivation to combine them and the Examiner does not provide a place in the system taught by the 410 patent where the anamorphic optics would be placed. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) MPEP 2143.01 There are at least several locations in the system taught in the '410 patent where the placement of anamorphic optics would render the '410 patent unsuitable for the purpose it was intended for. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) MPEP 2143.01.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

The Applicant respectfully states that a *prima facie* case of obviousness has not been established for claims 14 and 17.

However, since Patent No. 6,754,410 is not 35 U.S.C. 102(e) prior art (or 102 prior art in general), Applicants respectfully request that the Examiner find claims 4, 6, 9, 11-14 and 15-18 patentable.

V. Conclusion

In conclusion, in view of the above remarks and attached Declaration under 37 CFR 1.131, Applicant respectfully requests the Examiner find claims, 1-21, allowable over the prior art and pass this case to issue.

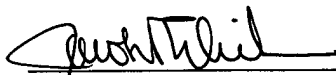
No additional fees are believed to be required for the entry of this response. If additional fees are required, they should be charged to Deposit Account No. 50-3718.

In accordance with Section 714.01 of the MPEP, the following information is presented in the event that a call may be deemed desirable by the Examiner:

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Respectfully submitted,
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Dated: April 24, 2006

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